In this Office Action, the Examiner rejected to independent Claims 1, 5, and 13 under 35 U.S.C. 102(e) as being anticipated by d'Eon et al., Pat. No. 6,006,197 (hereinafter d'Eon). Under a 102(e) rejection, the claim must be anticipated by the cited reference. Therefore, the reference must teach every aspect of the claimed invention either explicitly or impliedly, and any feature not directly taught must be inherently present. However, d'Eon does not teach every aspect of the Applicants' independent Claims 1, 5, and 13. Moreover, any features not directly taught by d'Eon are not inherently present in Applicants' independent Claims 1, 5, and 13. Accordingly, Applicants' respectfully traverse these rejections.

Applicants' independent Claim 1 provides "a method of providing information on advertisements viewed." Applicants' independent Claim 5 provides "a method of determining the reach and frequency of view of an advertisement." Applicants' independent claim 13 provides "a method of collecting information regarding advertisements viewed." In each of the rejected claims under 35 U.S.C. 102(e), the claimed methods provide information, determine reach and frequency, or collect information in response to a user *viewing of an advertisement.*

Contrary to Applicants' claimed invention, d'Eon requires that a user actually *clicks on an advertisement* and cannot provide information, determine reach and frequency, and collect information in response to a user *viewing an advertisement.* In fact, d'Eon's application includes the word *clicks* and *impressions* a number of times throughout the application, including in the sections highlighted by the Examiner (for example, see Abstract). Therefore it is not surprising that the only methods taught in d'Eon require that the user first *clicks on an advertisement.* For example, see d'Eon's Fig. 2, step 36 and Col. 4, lines 57-59 where it states "[t]he process begins at block 36, wherein a user *clicks on one of the banner advertisements* 30, 32, 34."

In conclusion, d'Eon requires to first *click on an advertisement,* it does not teach or disclose how to provide information, determine reach and frequency, and collect information in

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response to *viewing an advertisement*. And certainly, it is not an inherent feature to go from having to *click on an advertisement* to provide information, determine reach and frequency, or collect information, as in d'Eon, to only having to *view the advertisement* to provide information, determine reach and frequency, or collect information as in Applicants' presently claimed invention. Therefore, Applicants respectfully request that the Examiner remove the 102(e) rejection and consequently Applicants' independent Claims 1, 5, and 13 are allowable and dependent Claims 2, 3, 6, and 7 are then allowable as depending from allowable claims.

3. Rejections Under Section 103(a)

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation to modify the reference or to combine. Second, there must be a reasonable expectation of success. Finally, the prior art reference or references must teach or suggest all the claim limitations. The Examiner rejected independent Claims 1, 5, and 13 under 35 U.S.C. § 103(a) as being unpatentable over d'Eon. Furthermore, the Examiner rejected independent Claim 9 under 35 U.S.C. § 103(a) as being unpatentable over d'Eon in view of Marsh et al., Pat. No. 5,848,397 (hereinafter Marsh). Applicants' respectfully traverse these rejections.

There is no suggestion or motivation to modify d'Eon to provide information (see Claim 1, line 1), determine reach and frequency (see Claim 5, line 1), or collect information (see Claim 13, lines 1-2) in response to the *viewing of an advertisement*, as called for by Applicant's independent Claims 1, 5, and 13.

For example, according to the only methods taught or disclosed by d'Eon, if an advertisement wasn't clicked on, nothing would happen, because the methods taught or disclosed by d'Eon first requires a user to *click on an advertisement*. (For example, see the "flowchart of the present logic" in Fig. 2 and the figure description in Col. 4, lines 59 et seq.)

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Therefore, by viewing an advertisement on a system that utilizes the disclosed methods of d'Eon, then: ---No information on the advertisement would be provided.--- (As called for in Applicants' Claim 1, line 1). ---Reach and frequency information couldn't be determined.--- (As called for in Applicants' Claim 5, line 1). ---No information could be collected.--- (As called for in Applicants' Claim 13, lines 1-2).

Consequently, the methods disclosed in d'Eon are only helpful in gathering data if an advertisement is clicked on by a user. This is contrary to the Applicants' exemplary embodiment, which is a system that can measure the number of online users that are *presented with advertisements* (See Applicants' page 4, lines 21-22). Or according to another exemplary embodiment is a system that measures the number of times a banner image is *viewed by a network user* (See Applicants' page 5, lines 3-6).

Additionally, the Examiner rejected independent Claim 9 under 35 U.S.C. § 103(a) as being unpatentable over of d'Eon in view of Marsh. However, d'Eon in view of Marsh does not teach or suggest all of the claim limitations found in Applicants' independent Claims 9. In fact, Marsh does not address, suggest, or teach at least one of limitations that d'Eon fails to disclose, namely that information can be reported regarding advertisement images *viewed* on the computer. d'Eon in view of Marsh does not show Applicants' "panel computer" that includes "a second stored program for instrumenting the computer to report information regarding the *advertising images viewed* on the computer" (see Applicants' Claim 9, lines 1-3).

Because neither d'Eon, taken separately, or in view of Marsh, teach or suggest all of Applicants' claim limitations, the Applicants' respectfully request that the 35 U.S.C. § 103(a) rejections are removed. Accordingly, independent Claims 1, 5, 9, and 13 are allowable for at least the reasons stated above and all of the dependent claims including Claims 4, 8, 10-12, and 14-16 are dependent on allowable independent Claims.

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CONCLUSION

Applicants, therefore, respectfully submit that all pending claims 1-16 are allowable and the indication of allowance is earnestly requested. Therefore, Applicants respectfully request favorable reconsideration.

If any questions or issues remain, the Examiner is invited to immediately contact the undersigned attorney, Bradley J. Hulbert, at his direct dial number (312) 913-2122.

Respectfully submitted,

Date: July 23, 2001

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APPENDIX A

Version with Markings to Show Changes Made

In the Specification:

Paragraph on page 5, lines 3-6:

Accordingly, it is an object of the present invention to provide a method and apparatus which accurately measures the number of times a banner image [image] (or other image) is viewed by a network user, and which identifies the unique images viewed by each particular on-line user.

Paragraph on page 19, lines 3-9:

The components of Figure 3B are best understood by referring to the system's data collection process illustrated in the flowchart shown in Figure 4. In operation, a panel member first selects a URL using any of a number of conventional browsing methods, such as selecting a hyperlink or directly typing the URL into the [an] Internet browser 305 (Block 401). The proxy server 306 intercepts the URL request (Block 402) and passes the URL request onto the Internet 210, where the request is served in the conventional manner (Block 403).

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